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| APPLICATION NO. *  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------|
| 10/057,757   | 01/25/2002  | Makoto Tanaka        | 100809-00163(SCES<br>19.360)  | 9537             |
| 26304 7590 04/09/2007<br>KATTEN MUCHIN ROSENMAN LLP<br>575 MADISON AVENUE<br>NEW YORK, NY 10022-2585 |             |                      | EXAMINER<br>SHIFERAW, ELENI A |                  |
|  |             |                      | ART UNIT                      | PAPER NUMBER     |
|  |             |                      | 2136                          |                  |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 04/09/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/057,757 | <b>Applicant(s)</b><br>TANAKA ET AL. |  |
|                              | <b>Examiner</b><br>Eleni A. Shiferaw | <b>Art Unit</b><br>2136              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3-5, 12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 12 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-2, 6-11, 13-14, and 16 are previously withdrawn or non-elected.
2. Claims 3-5, 12, and 15 are presented for examination.

#### *Response to Amendment/Arguments*

3. Applicant's amendments/arguments with respect to all independent claims 3, 5, and 12 filed on 08/18/2006 have been fully considered but are not persuasive.

Regarding argument Harrison does not disclose or suggest many of the features, remark page 6 lines 4, argument is not persuasive because applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., many of the features) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding argument Harrison failure to disclose management information identifies the data storage device, remark page 6 lines 5-12, argument is not persuasive because applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Harrison discloses reading original version of management information/non scrambled key, first and second encrypted versions (U1 and U2 encrypted keys, respectively), decrypting first and second encrypted versions (S1 and S2, respectively), comparing original version Key with decrypted first and second keys, and if comparison is successful validating comparison key data and allowing decryption, wherein the keys are stored

in a storage device (see, col. 4 lines 55-col. 5 lines 5). Adiano et al. discloses reading stored hard drive serial numbers, decrypting encrypted serial numbers, comparing the decrypted serial number with the current serial number and if much occurs allowing access (see 0032, abstract and fig. 10).

Regarding argument neither references discloses or suggests that the data storage device subjected to verification is determined as valid when the comparison result indicates that the original version of the management information and both the respective first and second decrypted management information are in a predetermined relationship with each other, remark page 6 par. 2-page 7, argument is not persuasive because Harrison describes a method of protecting a selected set of files stored on a hard disk of a computer by encrypting a file with an encryption key, scrambling the encryption key with a first key/secret key, and scrambling the encryption key with a second key/algorithmic transform of the secret key and storing both said scrambled versions of the encryption key on said hard disk and validating the stored keys to provide decryption access to the files. Moreover, Adiano et al. discloses a method of secure software distribution and validates a receiver's device is a valid hard disk device by storing encrypted hard disk serial number into the system registry, reading and comparing hard disk serial number when application is launched and launching the application if the storage hard disk is authentic (see abstract, fig. 10 and par. 0032).

Regarding applicant's argument no motivation to combine the references and no suggestion and/or no motivation to be based on either of the references, remark page 8 par. 1, argument is not persuasive because sufficient motivation to combine is provided in the last OA page 4. And/or the rational to combine the references does not have to be stated in the prior art

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and may be reasoned from knowledge generally available to one ordinary skill in the art. See

MPEP 2144.

**“RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ARTRECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT**

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).”

All claims are rejected based on the same reason above.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Harrison USPN 5,870,468 in view of Adiano et al. US PG PUBs 2002/0073312 A1.

Regarding claims 3, 5, 12, and 15, Harrison discloses a method/system/computer program for

use in making an information processing system carry out the jobs:

reading an original version of management information (col. 4 lines 1-4 and col. 2 lines 2-9; *non scrambled key stored in the memory is read*) and a first and a second encrypted version

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of the management information out of the data storage device to be verified (col. 4 lines 55-col. 5 lines 5; *reading and original key, encrypted first key = U1, and encrypted second key = U2*);

decrypting the first and the second encrypted version of the management information the first and the second encrypted versions of the management information system being encrypted by different encryption key (col. 3 lines 41-52 and col. 4 lines 55-col. 5 lines 5; *unscrambling first key U1 to produce unscrambled first key = S1, and unscrambling second key U2 to produce unscrambled second key S2*);

comparing the read original version of the management information and the respective first and second decrypted management information (col. 5 line 5 and claim 8 element g; *comparing original version Key with decrypted first and second keys*); and

validating the verified data storage device when the comparison result indicates that the read original version of the management information and both of the respective first and second decrypted management information are in a predetermined relationship with each other (claim 8 element h, claim 2 element 26, and col. 1 lines 52-col. 2 lines 32; *if match occurs key is validated and decryption access is performed*).

Harrison discloses reading original version of management information/non scrambled key, first and second encrypted versions (U1 and U2 encrypted keys, respectively), decrypting first and second encrypted versions (S1 and S2, respectively), comparing original version Key with decrypted first and second keys, and if comparison is successful validating comparison key data and allowing decryption, wherein the keys are stored in a storage device (see, col. 4 lines 55-col. 5 lines 5). Harrison does not explicitly disclose the keys compared and validated are identifying the data storage device (management information being a device identifier). However

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Adiano et al. discloses reading stored hard drive serial numbers, decrypting encrypted serial numbers, comparing the decrypted serial number with the current serial number and if much occurs allowing access (see 0032, abstract and fig. 10).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the teachings of Adiano et al. within the system of Harrison because they are analogous in data protection. One would have been motivated to incorporate the teachings of device identifier comparison within the system of Harrison because it would validate the integrity of the device name stored on the storage and prohibit unauthorized alteration of device name in the storage.

Regarding claim 4, Harrison further discloses wherein the encrypted version of the management information is encrypted with an encryption scheme using secret key information and the decryption is performed with that secret key information (fig. 1 element 11 and col. 3 lines 16-53).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867.

The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser R. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



April 3, 2007

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4/3/07



